

"selected from the group consisting of protein Z and ZPI". Dependent Claim 11 was amended to recite the species "ZPI".

In the Office Action mailed August 7, 2003, the Examiner required election of a single disclosed species under 35 U.S.C. §121 for prosecution on the merits to which the claims will be restricted if no generic claim is finally held to be allowable.

The Examiner has stated that the claims are directed to two patentably distinct species of the claimed invention. Claim 8 was said to be directed to protein Z. Claims 11-12 were said to be directed to "protein Z plus ZPI". Claim 7 was said to be generic.

Applicant herewith traverses the restriction requirement on the ground that it is erroneous with respect to the stated species of Claims 11-12.

- That is, the Examiner's phrasing of the species of Claims 11-12 as being directed to "protein Z plus ZPI" is erroneously based on the claims as originally filed in the parent application wherein said claims are directed to the "combination of protein Z and ZPI."
- However, Claims 11-12 were amended by a Preliminary Amendment filed with the present divisional application on January 10, 2002, whereby said claims are directed to the species "ZPI" rather than the combination of "protein Z plus ZPI."

The ZPI species is included in the markush group of generic Claim 7 and is disclosed in the specification as a novel protease inhibitor useful as a blood coagulation inhibitor.

The species of "protein Z plus ZPI" was elected for prosecution in the parent application Ser. No. 09/696,364, as is evident from the attached copy of Claims 1-2 in U.S. Patent No. 6,369,031 that issued from said parent application. It is not seen how that species can be available for election in the present case since it would appear to be in conflict with the prohibition against double patenting.

Pursuant to 37 CFR § 1.142, Applicant herewith requests reconsideration of the requirement for restriction for the foregoing reasons and requests modification to state that the species of Claims 11-12 is "ZPI" as recited in the Preliminary Amendment.

In accordance with the required election of a single species, Applicant provisionally elects the species of Claims 11-12.

Respectfully submitted,



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Enc. (Copy of U.S. P. No. 6,369,031 – Claims 1-2)